Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte YORAM CURIEL

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Appeal No. 1999-0913
Application No. 08/723,330

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ON BRIEF

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Before ABRAMS, PATE, and MCQUADE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 23 through 25. These are the only claims remaining in the application. The invention is directed to a method for protecting information displayed on an article. The method includes providing a refractive image on the article that

prevents photocopying and also providing a write-resistant surface over information written on the article.

The claimed subject matter may be further understood with reference to the appealed claims which are appended to appellant's brief.

The reference of record relied upon by the examiner as evidence of lack of novelty is:

Takeuchi et al. (Takeuchi) 4,856,857 Aug. 15, 1989

The examiner has rejected claims 23 through 25 under 35 U.S.C. § 102 as unpatentable over Takeuchi.

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the determination that the applied prior art patent to Takeuchi does not establish the lack of novelty of the claimed subject matter. Accordingly, the rejection of all claims on appeal is reversed. Our reasons follow.

Anticipation under 35 U.S.C. § 102 requires that "each

and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.,* 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). If the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if that element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the reference, and that it would have been so recognized by persons of ordinary skill. *Robertson* at 745, 49 USPQ2d at 1950 (quoting *Continental Can Co. v. Monsanto Co.,* 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id*. at 745, 49 USPQ2d at 1951 (quoting *In re Oelrich,* 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

It is the examiner's finding that the combined embodiment variation of Takeuchi, embodiment D, may use the holograms of embodiments A-C. Thus, the examiner is of the view that Takeuchi teaches use of the hologram as shown in Figure 2 in the structures shown in Figure 15. The examiner refers to Column 18, lines 32-35 for such a teaching.

We are in disagreement with the examiner's finding that Takeuchi anticipates the claimed subject matter. Firstly, it is quite clear that Takeuchi actually refers to the disclosure of Figures 3-9, as being the holograms to be incorporated in the practical embodiments Figures 12-15. See col. 18, lines 43-54. The Figure 2 embodiment of Takeuchi is not an embodiment contemplated as being placed on the practical articles of Figures 12-15, since it does not contain an adhesive.

As the predecessor to our reviewing court has stated,

> "[i]t is to be noted that rejections under 35 U.S.C. § 103 are proper where the subject matter claimed "is not identically disclosed or described" (emphasis ours) in "the prior art," indicating that rejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically

> disclosed or described in 'the prior art.'" *In re Arkley,* 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972).

Thus, for the instant rejection under 35 U.S.C. § 102 to have been proper, the reference must clearly and unequivocally disclose the claimed subject matter or direct those skilled in the art to the claimed subject matter without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference. *Id*. Such picking and choosing may be entirely proper in the making of a § 103, obviousness rejection, where the applicant must be afforded an opportunity to rebut with objective evidence any inference of obviousness which may arise from the similarity of the subject matter which he claims to the prior art, but it has no place in the making of a § 102, anticipation rejection. *Id.* Secondly, in Takeuchi, the protective layer 34 is part of the hologram itself. Thus, if the hologram of Figure 2 were to be placed on the substrate of Figure 15, as the examiner suggests, the hologram on Figure 15 with its attached protective layer 34 would be removed.

Finally, we find persuasive appellant's comments that

protective layer 34 cannot be considered a write-resistant exposed surface, inasmuch as it is disclosed with a display portion 5 thereon. In this respect, the examiner cannot rely on display portion 5 as variable information on the one hand, and surface 34 as a write-resistant surface, since it shows display portion 5 lying thereon.

For the foregoing reasons it is our finding that the Takeuchi disclosure is not evidence of lack of novelty with respect to the claimed subject matter.

REVERSED

NEAL E. ABRAMS)
Administrative Patent Judge)
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) BOARD OF PATENT
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WILLIAM F. PATE, III Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
JOHN P. MCQUADE Administrative Patent Judge	)	

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